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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,732	01/07/2004	Norman H. Margolus	11656-004010	4745

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EXAMINER

EHICHIOYA, FRED I

ART UNIT PAPER NUMBER

2162

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/752,732	MARGOLUS, NORMAN H.	
	Examiner	Art Unit	
	Fred I. Ehichioya	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 114 - 116 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 114 - 116 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responsive to the communication filed January 7, 2004.
2. Claims 114 – 116 are pending in this Office Action.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees.

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 114 - 116 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over **Application Serial No. 10/752,733**. The mapping of the similar claims is as following:

Instant Application 10/752,732	Application 10/752,733
114	111
115	112
116	113

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are substantially similar in scope and they use the same limitations.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 114 - 116 are rejected under 35 U.S.C. 101 because:

Regarding claim 114, this claim is directed to receiving multiple clients browse content on a network such as the Internet. The claimed subject matter lacks a practical application of judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a useful result. Specifically, the claimed subject matter does not produce a useful result because the claimed subject matter fails to disclose a complete disclosure that contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful. Such a statement will usually explain the purpose of the invention or how the invention may be used (e.g., a compound is believed to be useful in the treatment of a particular disorder). Regardless of the form of statement of utility, it must enable one ordinarily skilled in the art to understand why the applicant believes the claimed invention is useful. More specifically, the claimed subject matter provides for **"associating a content data item already stored in the repository with an access authorization credential uniquely associated with an access owner"** which is a process. This produced result remains in the abstract and, thus, fails to produce a useful result. The claimed invention does not accomplish a "useful result" as forth in MPEP 2106 (II) (A).

Regarding claims 115 and 116, and in view of MPEP 2106 (II) (A), are not statutory because they recite computing steps without producing any concrete and useful result and/or being limited to a practical application within the technological arts. The claims are merely descriptive and lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. The claims do not accomplish a "practical application" as forth in MPEP 2106 (II) (A); therefore non-statutory.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 114 – 116 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pub. No. 2003/0177356 issued to Noel Abela (Hereinafter "Abela") in view of US Pub. No. 2004/0153431 issued to Kulvir Singh Bhogal (Hereinafter "Bhogal").

Regarding claim 114, Abela discloses a method by which multiple clients browse content on a network such as the Internet (page 1, [0016]), the method comprising:
each of the multiple clients accessing content on the network via one or more proxy servers (fig.1 and page 3, [0054]);

determining the digital fingerprint of an item of content passing through the proxy server (page 6, [0083]);

storing the item of content in a content repository connected to the proxy server at a location associated with the digital fingerprint (page 6, [0083]: "The resulting digital mark is stored locally in volatile memory by the client system");

testing for whether a content data item is already stored in the repository by comparing the digital fingerprint of the content data item to the digital fingerprints of content data items already in storage in the repository page 6, [0083]: "the client system in this case, asks the user's home uID database for the individual's digital biometric mark. It then compares the mark received to the one in its local volatile memory"); and

associating a content data item already stored in the repository with an access authorization credential uniquely associated with an access owner (page 1, [0016]: "This universal identifier, which from now on shall also be referred to as "uID", can be used along with a secret password or some other digital secrets and signatures by its holder to login and interact with all compliant web sites. It can be used to produce a trusted identity when it is asked for and to submit one's details securely and conveniently without the hassle of filling in a form every time").

Abela does not explicitly teach expiration time as claimed.

Bhogal discloses assigning an expiration time to the item of content (page 5, #3: "assigning a pre-designated expiration date"), before which time deletion is prohibited (page 4, [0049]: "If the time period has not expired, the process proceeds to step 812 to display a message prohibiting deletion of the message").

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Bhogal's teaching of "expiration time" would have allowed Abela's system to monitor and prevent unexpired data for deletion. The motivation is that data integrity is preserved.

Regarding claim 115, Bhogal discloses rules governing expiration (page 4, [0049]: the rule in this case is that data cannot be deleted for 20 days from the data of receipt) and deletion is distributed among a plurality of storage sites (Fig.1 and page 2, [0022]).

Regarding claim 116, Bhogal discloses the expiration time assigned to the item of content (page 5, #3: "assigning a pre-designated expiration date") depends upon expiration times assigned by the multiple clients (page 4, [0049] and page 5, [0053]).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred I. Ehichioya whose telephone number is 571-272-4034. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fred I. Ehichioya
Patent Examiner
Art Unit 2162



January 5, 2007


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